

## **REMARKS**

Claims 1-23 are pending in the Application, and all have been rejected in the Office action mailed November 14, 2006. Claims 1, 2, 3, 5, 7, 11, 16, 18 and 19 have been amended and new claims 24-29 have been added in this response. Claims 1 and 11 are independent claims. Claims 2-10 and 24-26, and claims 12-23 and 27-29 depend from independent claims 1 and 11, respectively. The Applicants respectfully request reconsideration of the pending claims 1-23, and consideration of new claims 24-29, in light of the following remarks.

### **Amendments to the Claims**

Claim 19 has been amended to correct a noted minor typographical error. Applicant respectfully submits that this amendment does not add new matter.

Claims 1, 2, 3, 5, 7, 11, 16, 18 and 19 have been amended to more clearly define the claimed subject matter and to correct noted minor typographical errors. Support for these amendments may be found, for example, in paragraphs [0017]-[0025] of the Specification, and in FIG. 1, FIG. 2 and FIG. 3 of the Drawings. Applicant respectfully submits that these amendments do not add new matter.

### **Objections to the Claims**

Claim 19 was objected to due to an informality. Claim 19 has been amended to correct an antecedent error. Applicant respectfully submits that the informality has been corrected, and requests that the objection to claim 19 be withdrawn.

### **Rejections of Claims**

#### **Rejections Under 35 U.S.C. §102(b)**

Claims 1-3, 5-17 and 20-23 were rejected under 35 U.S.C. 102(b) as being anticipated by Johansson et al. (US 5,418,837, hereinafter "Johansson"). The Applicant respectfully traverses the rejection. However, in an effort to more clearly describe Applicant's invention, Applicant has amended claims 1, 2, 3, 5, 7, 11, 16, 18 and 19, as set forth above.

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently

described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to amended claims 1 and 11, Applicant respectfully submits that Johansson fails to teach, suggest, or disclose, for example, “...at least one firmware component, functioning to update at least a portion of at least one of firmware and software using update information stored in the memory;...”, as recited in Applicant’s claim 1, and “...determining whether update information for updating the at least one of firmware and software is available in the memory, using information from the user removable electronic memory device;...”, as recited in Applicant’s claim 11.

Instead, Johansson teaches the following:

“...a software upgrading module card adapted to be temporarily connected to the mobile telephone by insertion into the module reader. The card comprises means for storing upgrading software to be transmitted into the main memory...”

(underline added)

(underline added, Abstract)

Johansson also states:

“If SUM card information is detected which indicates that the software in the mobile terminal is to be changed, for example, for providing solutions to software bugs, it is displayed on display 5 that "all software shall be altered" at step 80. The routine then changes all the software in the mobile terminal except that in the boot area in step 85 from information provided in the upgrading software stored in the SUM card.

If the answer at step 80 is no, it is detected at step 90 whether new features are to be installed in the mobile telephone. If so, the appropriate display is

presented on the mobile telephone in display 5, and control proceeds to step 95.

At step 95, the new features are installed in the mobile terminal from information provided in the upgrading software stored in the SUM card.

(underline added, col. 7, lines 9-23)

As set forth above, Johansson clearly teaches that the “upgrading software” is stored in memory (15’ of FIG. 1A and 1B) of the “software upgrading module card” (SUM card 22 of FIG. 1A, 22’ of FIG. 1B), and is transferred into the memory (15 of FIG. 1A) of the mobile telephone terminal. The Applicant respectfully submits that the “upgrading software” of Johansson is not present in the memory of the mobile telephone terminal (15 of FIG. 1A) before an upgrade and, therefore, that Johansson fails to teach or suggest that the mobile telephone terminal can “...update at least a portion of at least one of firmware and software using update information stored in the memory...”, as recited in Applicant’s claim 1. Applicant also respectfully submits that Johansson fails to teach or suggest “...determining whether update information for updating the at least one of firmware and software is available in the memory, using information from the user removable electronic memory device...”, as recited in Applicant’s claim 11.

Based at least upon the above, Applicant respectfully submits that Johansson fails to teach each and every element of Applicant’s claims 1 and 11 as required by M.P.E.P. §2131, and that a rejection of claims 1 and 11 under 35 U.S.C. §102(b) cannot be maintained.

Therefore, Applicant believes that amended claims 1 and 11 are allowable, for at least the reasons set forth above. Applicant respectfully submits that claims 2-10 and 24-26, and claims 12-23 and 27-29 depend either directly or indirectly from claims 1 and 11, respectively. Because claims 2-10 and 24-26, and claims 12-23 and 27-29 depend, respectively, from allowable claims 1 and 11, Applicant respectfully submits that claims 2-10, 12-23, 24-26 and 27-29 are also allowable over Johansson. Therefore, Applicant respectfully requests that the rejection of claims 1-3, 5-17 and 20-23 under 35 U.S.C. §102(b), be withdrawn.

### **Rejections Under 35 U.S.C. §103(a)**

Claims 4, 18 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Johanson in view of Ericsson (US 6,556,842) The Applicants respectfully traverse the rejection.

The Applicants respectfully submit that the Examiner has failed to establish a case of *prima facie* obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” The M.P.E.P. §2142 goes on to state that “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

Applicant respectfully submits that claim 4 and claims 18 and 19 depend either directly or indirectly from independent claims 1 and 11, respectively. Applicant believes that independent claims 1 and 11 are allowable over the proposed combination of references, in that Ericsson fails to overcome the deficiencies of Johansson, as set forth above. Because claims 4, 18 and 19 depend from allowable claims 1 and 11, Applicants respectfully submit that claims 4, 18 and 19 are also allowable over the proposed combination of Johansson and Ericsson, for at least the reasons set forth above with respect to claims 1 and 11. Applicants respectfully request, therefore, that the rejection of claims 4, 18 and 19 under 35 U.S.C. §103(a) be withdrawn.

### **Newly Added Claims**

Applicant has added new claims 24-29 by this amendment. Claims 24-26 and claims 27-29 depend either directly or indirectly from claims 1 and 11, respectively. Support for claims 24-29 may be found, for example, at paragraphs [0017]-[0022] and [0033] of the Specification. Applicant respectfully submits that no new matter is added by these new claims.

### **Conclusion**

In general, the Office Action makes various statements regarding claims 1-23 and the cited references that are now moot in light of the above. Thus, Applicant will not address such statements at the present time. However, Applicant expressly reserves the right to challenge

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such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicant believes that all of pending claims 1-29 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicant invites the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees required by this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

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